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**REMARKS****I. Introduction**

Claims 1-6, 8, 10-14 and 20-22 are pending. In the January 16, 2004 Final Office Action the Examiner rejected claims 1-3, 6, 10, 12 and 20-22 under 35 U.S.C. §103(a) as being unpatentable over Adams et al. (U.S. Patent 6,631,186). The Examiner confirmed in a March 2, 2004 telephone conversation that the Office Action included an error in identifying the Adams patent as 5,452,349 (a previously applied reference) and that Patent No. 6,631,186 to Adams et al. was the applied reference. The March 2, 2004 conversation did not include any discussion of the prior art other than the patent number of the reference.

In the Office Action, the Examiner also rejected claims 4, 5, 8, 11, 13 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Adams et al. in view of Hallenstal (U.S. Patent No. 6,125,126).

In all of the rejections, the Adams et al. patent (6,631,186) is used as the primary reference. The Examiner has failed to establish that this reference is prior art to the present application. Accordingly, given the absence of any showing that the Adams et al. patent is prior art, the rejection of the pending claims should be withdrawn.

**II. The Examiner has Failed to Make the Required Prima Facie Showing Necessary to Reject the Claims**

It is well established that the Examiner, in order to reject claims has the burden of establishing a prima facie case that the claims are unpatentable.

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In re Warner 54 CCPA 1628, 379 F.2D 1011, 154 USPQ 173, 177 (1967) states:

We think the precise language of 35 U.S.C. 102 that "a person shall be entitled to a patent unless," concerning novelty and obviousness, clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103 ...

In keeping with this principle, with regard to rejections based on a reference, the burden is on the Examiner to establish that a reference is, in fact, prior art.

In National Rolled Thread Die v. Ferry Screw Products, 192 USPQ 358, 362 n5, (6th Cir. 1976) it was recognized that:

[T]he Court of Customs and Patent Appeals has placed the burden of proving prior art status on the examiner and not on the Applicant in an ex parte proceeding. Id.

The Examiner has failed to establish that the Adams et al. patent is prior art to the present application. Accordingly, the rejection based on the Adams et al. patent should be withdrawn.

The present application has a filing date of June 30, 2000 which precedes the Nov. 21, 2002 filing date of the Adams et al. patent. Accordingly, the Adams et al. patent, absent further evidence by the Examiner, is presumed NOT to be prior art to the present application.

The issue of when a CIP is entitled to the date of an earlier application for 102(c) purposes is addressed in detail *In re Wertheim*, 646 F.2D 527, 209 USPQ 554, 561 (CCPA 1981) which is cited in MPEP 2136.03 which discusses 102(e) rejections based on CIP applications. A copy of this case is submitted herewith for the

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Examiner's convenience. Applicants request that the Examiner review the case since it makes the shortcomings of the Examiner's current rejection clear.

Given that the Adams et al. patent has a later filing date than the present application, in order to reject the claims based on the Adams et al. patent **the Examiner has the burden of establishing that it has an effective 35 U.S.C. §102(e) date for the material used to reject the claims which is earlier than the current application's filing date.** As discussed above, the Examiner has not done this.

The Adams et al. patent claims to be a continuation-in-part of Application S.N. 09/619,312 filed on July 19, 2000. The July 19, 2000 filing date is after the filing date of the present application. Thus, the '312 application is not early enough to provide a 102(e) date to reject the claims.

The Adams et al. patent also claims to be a continuation-in-part of application No 09/545,459, filed April 7, 2000 and claims the benefit of Provisional application No. 60/128,474 filed on April 9, 1999. While both of these applications have an earlier filing date than the present application, **the Examiner has not established that the filing dates of these Applications can be used as an effective 102(e) date.** Applicants note that **the Examiner has not provided copies of these applications and has not discussed their content at all.** Accordingly, the Examiner has failed to make any showing that the Adams et al. patent is prior art to the present application.

The case law and MPEP make it clear that the Examiner can **NOT** simply assume, in the case of a CIP that an issued patent has an effective 102(e) date corresponding to the earliest filing date upon which priority is claimed. This is because the earlier case may not disclose the subject matter being used to reject the

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claims or was not in condition to issue as a patent and therefore is not entitled to a 102(e) date.

**If the Examiner is to reject the pending claims based on the Adams et al. patent (6,631,186), the Examiner has the burden of:**

- 1) establishing that the subject matter being relied upon by the Examiner in the Adams et al. patent to reject the claims "was carried over" from an earlier application upon which the Adams et al. patent claims priority that has a filing date earlier than the present application;(See, *In re Wertheim*, 646 F.2D 527, 209 USPQ 554, 561 (CCPA 1981) and
- 2) determining that the application relied upon for the priority date used to reject the claims **supported one or more claims in the issued Adams et al. patent in the manner required by 35 U.S.C. 112, first paragraph. (Id.)**

With regard to 1) Applicants note that the Examiner has failed to show support in the parent application(s) for the subject matter in the Adams et al. patent used to reject the claims.

With regard to 2) Applicants note that they could not find any issued patent based on the 09/545,459 application upon which the Adams et al patent claims priority. Accordingly, there is a real issue as to whether the parent application can support a 102(e) date given that it presumably has a different content than the Adams et al. patent. Applicants note that each of the independent claims in the Adams et al. patent are relatively detailed. **The Examiner has not supplied any evidence that one or more of the independent claims of the issued Adams et al. patent are fully supported by the priority application so the question of whether the priority application fully supports an independent claim of the Adams et al. patent as required by 35 U.S.C. §112, first paragraph, remains to be resolved before the Examiner can use the Adams et al. patent as prior art. (bold added for emphasis)**

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With regard to item (2) above, MPEP 2136.03 which discusses relying on a parent's filing date to reject claims when a reference is a continuation-in-part of the parent states:

In order to carry back the 35 U.S.C. 102(e) critical date of the U.S. Patent reference to the filing date of a parent application, the parent application **must (A) have a right of priority to the earlier date under 35 U.S.C. 120 >or 365(c)< and (B) support the invention claimed as required by 35 U.S.C. 112, first paragraph. "For if a patent could not theoretically have issued the day the application was filed, it is not entitled to be used against another as 'secret prior art'" under 35 U.S.C. 102(e). *In re Wertheim*, 646 F.2D 527, 537, 209 USPQ 554, 564 (CCPA 1981) (Bold added for emphasis)**

MPEP §2136.03 goes on to indicate that the Examiner must determine which parent application first disclosed the claimed subject matter of the issued patent (Adams et al) to determine the earliest possible 102(e) date and whether the patent fully supported at least some claims which ultimately issued.

MPEP 2136.03 states:

***In re Wertheim*, 646 F.2D 527, 537, 209 USPQ 554, 564 (CCPA 1981) (The Examiner made a 35 U.S.C. 103 rejection over a U.S. patent to Pfluger. The Pfluger patent (Pfluger IV) was the child of a string of abandoned parent applications (Pfluger I, the first application, Pfluger II and III both CIPs). Pfluger IV was a continuation of Pfluger III. The court characterized the contents of the application as follows: Pfluger-I - subject matter A, II-AB, III ABC, IV-ABC. ABC anticipated the claims of the examined application, but the filing date of III was later than the application filing date. So the examiner reached back to "A" in Pfluger I and combined this disclosure with another reference to establish obviousness. The court held that the examiner impermissibly carried over "A" and should have instead determined which of the parent**

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applications contained the subject matter which made Pfluger patentable. Only if B and C were not claimed, or at least not critical to the patentability of Pfluger IV, could the filing date of Pfluger I be used. The court reversed the rejection based on a determination that Pfluger IV was only entitled to the Pfluger III filing date. The added new matter (c) was critical to the claims of the issued patent.) Id. (bold added for emphasis)

The Examiner in rejecting the current claims based on the Adams et al. patent seems to have made the same mistake warned about in the MPEP and the case cited therein. That is, the Examiner has impermissibly carried over the filing date of the first application when the Examiner should have instead determined, among other things, which of the parent applications contained the subject matter which made Adam et al. patent patentable.

In view of the above discussion, it is clear that the Examiner has failed to established a prima facie case that the Adam et al. patent is prior art to the present application. Accordingly, the rejection based on the Adam et al. patent should be with drawn.

Given that each of the rejections is based on the Adam et al. patent, Applicants respectfully submit that all of the rejections have been overcome.

### III. Request for Clarification

If the Examiner issues any future rejections based on the Adams et al. patent, it is respectfully requested that the Examiner

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- 1) indicate which priority application is being used to establish a 102(e) date that is earlier than Applicants' filing date;
- 2) specifically identify, e.g., with column and line cites, the blocks of text and figures in the Adams et al. patent upon which any rejections of the claims are based.
- 3) specifically identify where each block of text and figure identified in response to (1) can be found in the priority application ;
- 4) identify in the priority application where support can be found for each and every element of at least one of the independent claims in the issued Adams et al. patent.

As discussed above, **the Examiner bears the burden of providing at least this much information since each of the enumerated requests clearly relates to what must be shown to establish the Adams et al. patent as prior art.** So that Applicants can be given a fair opportunity to review the Examiner's analysis it is requested that the Examiner provide copies of the priority applications which the Examiner decides to use to make a prior art determination.

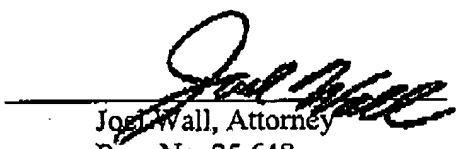
#### **IV. Conclusion**

Claims 1-6, 8, 10-14 and 20-22 are pending. The application is in condition for allowance.

**If there are any outstanding issues that need to be resolved to place the application in condition for allowance the Examiner is invited to contact Applicants' undersigned representative to discuss said issues.**

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Respectfully submitted,

March 16, 2004  
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**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this paper (and any accompanying paper(s)) is being facsimile transmitted to the United States Patents and Trademark Office at facsimile number 703-872-9306 on the date shown below.

  
Christian Andersen3-16-04  
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